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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,715	11/16/2000	Timothy G.J. Jones	57.0272PCT	6188

7590 12/07/2001

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EXAMINER

LIPMAN, BERNARD

ART UNIT PAPER NUMBER

1713

DATE MAILED: 12/07/2001

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/646,715

Applicant(s)

JONES ET AL.

Examiner

Bernard Lipman

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit 1713

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gregor et al., U.S. Patent 5,280,078.

Reference to Gregor et al. specifically teaches an assortment of polymers containing both hydrophilic and hydrophobic moieties with a variety of cross-linking possibilities and formation of gel polymers therefrom. These polymers are representative of polymers which are suitable for use as required in applicants' claims and would possess,

Art Unit 1713

presumably, the characteristics required by the preamble of applicants' claims absent evidence to the contrary commensurate in scope to the claims. Indeed, many of the cited references would read on applicants' claims and presumably be usable as a basis for a 102 or a 103 rejection therefrom as indicated in the earlier search reports on the PCT application. This is especially true in view of the breadth of applicants' claims. Applicants' claims are, therefore, properly rejected either under 35 U.S.C. § 102 or 103 as anticipated or rendered prima facie obvious from the prior art as cited.


2. Claims 1-9 are rejected under 35 U.S.C. § 112, first paragraph as being broader than one of ordinary skill in the art is enabled, from the disclosure, to practice the invention. Applicants have given enough information to one of ordinary skill in the art to use specific polymers with specific cross-linking agents. The claims are nowhere drawn to these polymers. The claims do not in any way chemically identify polymers being claimed except for functionalities such as possessing cross-linking moieties and hydrophobic or hydrophilic properties in certain areas. These functionalities are too broad for one of ordinary skill in the art to be able to predict, in the breadth of the claims, what polymers are encompassed by the claims and how to use said polymers as disclosed. The disclosure teaches specific acrylic or acrylamide polymers with specific

Serial No. 09/646,715

-4-

Art Unit 1713

functionalities. Even the cross-linking of claims 8 and 9 which have not been seen in the prior art specifically for the polymers as cited, would only be commensurate in scope to the disclosure insofar as being presented in combination with identified polymers. These polymers must be identified by chemical structure in order to be commensurate in scope to the enabling disclosure. The claims are, therefore, properly rejected under 35 U.S.C. § 112 as being broader than one of ordinary skill in the art is enabled by the disclosure to practice the invention.


Bernard Lipman
Primary Examiner
Art Unit 1713

BL:cdc
December 3, 2001